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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,281	08/04/2005	Gordon Calundann	2011.9	7691
29494 7590 12/21/2010 HAMMER & ASSOCIATES, P.C. 3125 SPRINGBANK LANE SUITE G CHARLOTTE, NC 28226				
EXAMINER				
TRUONG, DUC				
ART UNIT		PAPER NUMBER		
1765				
MAIL DATE		DELIVERY MODE		
12/21/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,281

Applicant(s)

CALUNDANN ET AL.

Examiner

Duc Truong

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 12/10/10.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/10/10 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Savinell et al (5525436) of record on 1449.

The reference discloses the reactant and the cited condition to form a proton conducting polymer membrane comprising PBZ (See col. 2, line 51 to col. 7, line 63 and claims 1-32) using phosphoric or sulfuric acid.

The disclosure of the reference differs from the instant claims in that it neither disclose the steps of the process nor the use of a polyphosphoric acid/sulfonating agent mixture to form the claimed proton conducting polymer membrane.

However, this is the claimed product by process which is considered the claimed product by itself unless Applicant provides evidence to show the unexpected characteristics by using different steps of the process, or alternatively, the differences between the claimed polyphosphoric acid/sulfonating agent mixture and the sulfuric acid, as disclosed in the reference.

The reference does disclose the proton conducting polymer membrane which is based on sulfonated polymer comprising benzimidazole units, as required in the claims. Therefore, it would have been obvious to one of ordinary skill in the art to select the sulfuric acid as the replacement of polyphosphoric acid/sulfonating agent mixture since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results, a proton conducting membrane. There is no showing of unexpected results derived from said use.

Note that the Declaration has been submitted in to support for Applicant's arguments. However, said arguments have been fully considered but they are not persuasive since they are not commensurate in scope with the claims in that no comparative Examples have been disclosed between the use of the claimed polyphosphoric acid/sulfonating agent mixture and phosphoric acid or sulfuric acid, as disclosed in the reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 and 20-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32, 1-74, 1-25 and 1-19 of U.S. Patent No. 7,235,320, 7384552, 7540984 and 7582210 in view of 7332530 (claims 1-28).

Claims 1-32 of '320, 1-74 of 552, 1-25 of '984 and 1-19 of '210 disclose the claimed product by process or method ('984) with the required reactants under cited conditions, as in the instant claims.

However, the differences are they do not disclose the formation of sulfonated polymers comprising benzimidazole units in the presence of polyphosphoric acid/sulfonating agent mixture, as in the instant claim 1.

Claims 1-28 of '530 disclose in step A, the mixing of a sulfonating agent (vinyl containing sulfonic acid) with (ii) components, in the presence of polyphosphoric acid.(see claim 1 of '320, '552, 984 and '210).

It would have been obvious to one of ordinary skill in the art to form the proton conducting polymer membrane of '320, '552, '984 and '210 employed the sulfonating agent in step A of '530 in order to gain the advantages of the combination of the references, that being polymer comprising benzimidazole would be sulfonated and having the added properties such as outstanding chemical and thermal properties (see col. 1, lines 14-19).

The polymer comprising benzimidazole units of '320, '552, '984 and '210 would be sulfonated by using the sulfonating agent, as disclosed in claim 1 of '530 to form the sulfonated polymers having the added properties would not provide any unexpected results to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Duc Truong/
Primary Examiner, Art Unit 1765